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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.     |
|--|-------------|----------------------|---------------------|----------------------|
| 09/690,199   | 10/16/2000  | Billy P. Taylor      | 28150.7             | 2251                 |
| 27685  | 7590        | 12/03/2003           |                     | EXAMINER             |
| HAYNES AND BOONE, LLP<br>600 CONGRESS AVENUE<br>SUITE 1600<br>AUSTIN, TX 78701 |             |                      |                     | EL CHANTI, HUSSEIN A |
|  |             |                      | ART UNIT            | PAPER NUMBER         |
|  |             |                      | 2157                |                      |

DATE MAILED: 12/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                     |                  |
|------------------------------|---------------------|------------------|
| <b>Office Action Summary</b> | Application No.     | Applicant(s)     |
|                              | 09/690,199          | TAYLOR, BILLY P. |
|                              | Examiner            | Art Unit         |
|                              | Hussein A El-chanti | 2157             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 October 2000.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) \_\_\_\_\_ is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6,8.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

1. This action is responsive to application filed on Oct. 16, 2000. Claims 1-21 are pending examination.

### *Claim Objections*

2. Claims 5, 12 and 19 are objected to because of the following informalities:

The second line of the claim states "the a visual". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by

Milovanovic et al., U.S. Patent No. 6,484,198 (referred to hereafter as Milovanovic.

As to claim 1, Milovanovic teaches a method performed by a computer system comprising:

storing a version of a mass-produced printed paper (see col. 5 lines 1-7 and col. 1 lines 46-50 and lines 29-37); and

forming a reference within the version, the reference being associated with an operation and at least a portion of the version, the version being displayable on a

display device as a likeness of the paper and the portion being selectable to cause performance of the operation (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37).

As to claim 2, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the portion is displayable on the display device as a likeness of an advertisement within the paper (see col. 1 lines 60-64).

As to claim 3, Milovanovic teaches the method of claim 2 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a hyperlink to a website associated with the advertisement (see col. 2 lines 11-24).

As to claim 4, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a hyperlink to a website and wherein the operation includes displaying the website (see col. 2 lines 11-24).

As to claim 5, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes displaying a visual image in response to the file (see col. 3 lines 50-57 and col. 2 lines 34-36).

As to claim 6, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes outputting audio signals in response to the file (see col. 2 lines 34-36).

As to claim 7, Milovanovic teaches the method of claim 1 wherein the forming comprises:

forming the reference within the version wherein the reference specifies a script and wherein the operation includes executing the script (see col. 2 lines 46-57).

As to claim 8, Milovanovic teaches a system comprising:

storing a version of a mass-produced printed paper (see col. 5 lines 1-7 and col. 1 lines 46-50 and lines 29-37); and

forming a reference within the version, the reference being associated with an operation and at least a portion of the version, the version being displayable on a display device as a likeness of the paper and the portion being selectable to cause performance of the operation (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37).

As to claim 15, Milovanovic teaches a computer program product comprising a computer program processable by a computer system for causing the computer system to:

store a version of a mass-produced printed paper (see col. 5 lines 1-7 and col. 1 lines 46-50 and lines 29-37); and

form a reference within the version, the reference being associated with an operation and at least a portion of the version, the version being displayable on a display device as a likeness of the paper and the portion being selectable to cause performance of the operation (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37); and

an apparatus from which the computer program is accessible by the computer system (see col. 1 lines 60-64, col. 2 lines 11-24 and col. 3 lines 33-37).

**4.** Claims 9-14 and 16-21 do not teach or define any additional limitation over claims 1-7 and therefore are rejected for similar reasons.

***Conclusion***

**5.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- System And Method For Structured News Release Generation And Distribution by Shapiro et al., U.S. Patent No. 6,370,535.
- Regulating Access To Digital Content by Patterson, U.S. Patent No. 6,389,541.

**6.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein El-chanti whose telephone number is (703)305-4652. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone numbers for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Hussein El-chanti

Date: Nov. 5, 2003



ARIO ETIENNE  
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